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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,313

Applicant(s)

CHIN, STEPHEN

Examiner

Harish T Dass

Art Unit

3628

mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9 & 13 1/2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner was unable to find the following limitation or suggestion in original specification "in response to and substantially contemporaneous with consummation of a transaction between the sender and recipient" particularly the "substantially contemporaneous" could not be found in original specification.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 13-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings et al (Hereinafter Jennings, US Pat. 5,825,003) in view of Schrader et al (hereinafter Schrader – 5,903,881).

Re. Claim 11, Jennings discloses storing in a stored value account (place transfer funds into transfer holding fund) of a sender electronic funds that are available for transfer to a recipient [see entire document particularly, abstract; figures; C2 L36-L62; C4 L1-L5; C26 L56-L60; C27 L58-L62], receiving a request over ATM Network (through the use of a terminal such as an ATM, home banking phone, personal computer, conventional telephone or the like) at a server computer to transfer at last some of the funds in the stored value account to a recipient in response to and substantially contemporaneous (instantly) with consummation (settlement) of a transaction between the sender and recipient [abstract; C1 L45 to C2 L62; C3 L50 to C4 L13; C5 L42 to C5 L55 to C6 L40; C27 L48 to C28 L22], sending the requested funds to the recipient () [C4 L1-L5; C13 L44 to C14 L40: C18 L20-L67], and debiting the stored value account [C5 L30-L40; C8 L3-L43; C27 L48 to C28 L20]. Jennings discloses electronic fund transfer over the ATM network or the like. But, Jennings does not explicitly disclose transfer over the Internet. However, Schrader et al (hereinafter Schrader – 5,903,881) discloses online banking and electronic fund transfer system and use of Internet [Abstract; C12 L35-L53; C13 L45-L60] to access financial institution computer system. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Jennings and Schrader to enable the personal online finance application to use various online environment such as Internet Explorer.

Re. Claim 15, Jennings discloses receiving a request from a sender at a server computer to transfer funds to a recipient, wherein the request includes information on a payment instrument to be used to pay the funds to the recipient [C3 L50-L67; C4 L14-17; C5 L42 to C6 L40; C27 L48 to C28 L22], from the computer, sending an authorization request to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C17 L45-L67], receiving at the server computer an authorization to charge the payment instrument [Abstract; Figures 12-14; C1 L45 to C2 L62; C26 L52 to C27 L20; C5 L9-L30; C17 L45-L67], and providing the requested funds to the recipient [C5 L42 to C6 L8; C9 L17 to C10 L50; C28 L1-L22]. Jennings does not explicitly disclose server computer. However, Schrader discloses server computer [Figure 13; C12 L28 to C13 L7; C15 L5-L27] to allow the Internet based communication. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and include computer server, as taught by Schrader, to allow the client computer download a configuration file which contains the financial institutions description information.

Re. Claims 13-14 and 17-18 Jennings discloses confirmation message is displayed to the customer [C9 L17-L32; C11 L10 to C12 L50; C14 L29-L45]. Jennings does not explicitly disclose email. However, Schrader discloses email messages [C19 L25-L45] to allow the user to receive email message from financial institution or send message to financial institutions. It would have been obvious at the time the invention was made to

a person having ordinary skill in the art to modify the disclosure of Jennings and add email to allow the user to get message for inquiries about specific transactions.

Re. Claims 19 and 20, Jennings discloses wherein the recipient is a merchant (point of sale) [C8 L38].

Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jennings in view of Schrader as applied to claims 11 & 15 above, and further in view of Nethery (US 6,070,798).

Re. Claims 12 and 16, neither Jennings nor Schrader discloses generating a money order in the name of the recipient, and wherein the requested funds are sent by sending the money order. However, Nethery discloses this step [Abstract; Figure 5; C1 L5 to C2 L38] to enable remote purchase over a network. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Jennings and Schrader to add money negotiable instrument such as money order to be send through electronic communication link.

Response to Arguments

3. Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

Jeanne O'Brien, Feb. 1999 "CIBC arms clients with Internet access" discloses electronic transfer and banking functions including electronic payment mechanism such as money order over the Internet.

US 6,149,057 to Hollis, Nov. 21, 2000 "System and method for transfer of funds using preprinted sealed security code packet and automated teller machine", discloses a currency transfer system which does not require the generation of unique personal identification numbers during a transfer of currency, which eliminates the necessity of transmitting PIN numbers and other security codes between a host computer and the sender of currency, and which does not require the recipient of the funds to enter in an ATM the amount of currency being transferred to the recipient.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

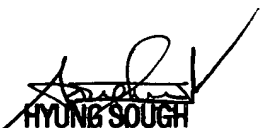
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Souh can be reached on 703-308-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harish T Dass
Examiner
Art Unit 3628
5/10/04


HYUNG SOUH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600